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EXAMINER
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LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/020,712

Applicant(s)

PAINE ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 66-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 66, 67, 69, 71-76 and 78-84 is/are rejected.
- 7) ☐ Claim(s) 68, 70 and 77 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/13/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

*Continued Examination*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/13/2005 has been entered.

*Claim Status:*

Claims 66-84 are pending; claims 1-65 have been cancelled. Claims 68, 70 and 77 are objected to and claims 66, 67, 69, 71-76 and 78-84 are rejected as detailed below.

*Specification*

The attempt to claim priority by reference to application serial No 09/911,674 filed July 24, 2001 and application serial No. 09/322,677 filed on May 28, 1999 is improper because the above applications do not support the limitations of the newly revised claims.

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. At least paragraphs 6, 8 and 99 include an embedded hyperlink.

*Claim Objection*

Claims 68, 70 and 77 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 68 recites “determining a quality metric for each candidate search term.” Each candidate search term does not further limit any of the elements of claim 66.

Claim 70 is objected to for being dependent from a rejected claim.

Claim 77 recites “determining a quality metric for candidate search terms and predicting relevance of candidate search terms based on the quality metric.” Candidate search terms does not further limit any of the elements of claim 76.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 66-84 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 66 recites “obtaining a set of potential search terms.” The specification does not contain a clear and concise description of the claimed computer-implemented method of obtaining a set of potential search terms such that the skilled artisan can make and use the invention.

Claim 66 recites “other information providers.” The specification does not contain a clear and concise description of other information providers such that the skilled artisan can make and use the invention.

Claim 66 recites “a new information provider.” The specification does not contain a clear and precise description of a new information provider such that a skilled technician can make and use the invention.” In particular, paragraph 31 of the specification indicates that a server acts as an information provider; paragraph 35 includes various network providers such as account management server 22, search engine server 24, advertising server 14 and paragraph 39 states that client computers 12 may be network information providers such as advertising web site promoters or owners having advertiser web pages 30 located on web server 14. The skilled technician would not be able to make and use the invention because it is unclear which one of the above plurality of servers is the “new information provider.”

Claim 66 recites “receiving from the new information provider at an input device an indication of accepted search terms.” The specification does not contain a clear and concise description of the claimed computer-implemented method of receiving accepted search terms from the new information provider such that the skilled artisan can make and use the invention.

Claim 66 recites repeating (b) through (e) until a completion indication is received from the new information provider.” The specification does not contain a clear and concise

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description of the claimed computer-implemented method of receiving a completion indication such that a skilled artisan can make and use the invention.

Claim 66 recites “sorting the potential search terms according to the computed estimated ratings.” The specification does not contain a clear and concise description of the claimed computer-implemented method of “sorting the potential search terms” such that a skilled artisan can make and use the invention.

Claim 79 is rejected on a basis similar to claim 66

Claims 67-78 and 80-84 are rejected for being dependent from a rejected base claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 66, 71, 75, 76, 78, 79, 83 and 84 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,314,420 issued to Lang et al (hereafter Lang), as best examiner is able to ascertain.

#### **Claims 66 and 75:**

Lang discloses:

(a) obtaining search terms [user enters query, col 1, lines 17-25, col 1, lines 55-60]

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- (b) computing correlations between the search terms and search terms in a database [query is profiled in storage on a content basis and adaptively updated over time, col 1, lines 56-60]
- (c) computing an estimated rating for the search terms [informons<sup>1</sup> are compared to the query profile by relevancy ranking, col 1, lines 55-60, col 23, lines 33-38, col 1, lines 40-45]
- (d) sorting the search terms [Figs 1-7 and col 24, lines 49-60]
- (e) presenting the search terms [col 1, line 65 – col 2, line 3]
- (f) receiving accepted search terms [col 2, lines 5-20]
- (g) completing receiving accepted search terms [col 2, lines 5-20]

**Claims 71, 78 and 83:**

Lang discloses receiving data from one or more pages of the website and examining text from the one or more pages for candidate search terms [col 4, lines 23-30].

**Claim 76:**

Lang discloses predicting a likelihood that a search term will be relevant to the advertiser [col 2, lines 5-20].

**Claim 79:**

Lang discloses

an account management server including a processing system which is operative in conjunction with program code to recommend potential search terms to a new information

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<sup>1</sup> Informons read on search terms because Lang discloses in column 1 lines 23-27 that “the search site typically employs a spider scanning system and a content based filter in a search engine to search the internet and find information which match the query. This process is basically a pre-search process in which matching informons are found at the time of initiating a search for the user’s query, by comparing informons in an informon data base to the user’s query.” This is in line with applicant’s Abstract which states that a first technique involves looking for search terms directly on an advertiser’s web site.

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provider adding search listings to the database [spider plus content-based filter, col 1, lines 20-25];

collaborative filtering code operable in conjunction with the processing system to compute correlations between potential search terms for the new information provider and search terms of other information providers stored in the database and to compute an estimated rating for the each potential search term for the new information provider [col 1, lines 45-65],

sorting code operable in conjunction with the processing system and configured to sort the potential search terms according to the computed estimated ratings [col 1, line 65 through col 2, line 5];

an output device configured to provide the sorted potential search terms to the new information provider for review [Fig 9, search return processor 48C, col 26, lines 1-8]; and

an input device configured to receive from the new information provider an indication of accepted search terms [Fig 9, 34C, col 25, lines 5-20, col 26, lines 1-8]

**Claim 84:**

Lang discloses wherein the spidering code is configured to include terms scoring above a threshold score among the sorted potential search terms [Abstract].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 67, 72-74 and 80-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang as noted above in claims 66 and 79 in view of US Pat No 6,078,916 to Culliss (hereafter Culliss), as best examiner is able to ascertain.

**Claims 67, 69, 73, 74, 80, 81 and 82:**

Lang discloses the essential elements of the claimed invention as noted above and furthermore, Lang discloses spidering the website to obtain search terms for the set of potential search terms [col 1, lines 20-25] but does not disclose receiving from the new information provider a website uniform resource locator (URL). Culliss discloses receiving from the new information provider a website uniform resource locator (URL) [col 29, lines 30-45]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lang to include receiving from the new information provider a website uniform resource locator (URL) as taught by Culliss for the purpose of adopting the well-known means of accessing a website such that information can be down-loaded from the website.

**Claim 69:**

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The combination of Lang and Culliss discloses the elements of claims 66 and 67 as noted above and furthermore, Lang discloses combining a rating based on the computed correlations and a rating based on the quality metric determined for each candidate search term [ col 1, lines 40-45].

**Claim 72:**

Lang discloses the elements of claims 66 and 71 as noted above and furthermore Lang discloses examining substantially all text from the one or more pages and Culliss discloses examining meta tags from the one or more pages [col 5, lines 15-20].

***Response to Arguments***

Applicant's arguments filed 7/13/2005 with respect to claims 66-84 have been considered but are moot in view of above new ground(s) of rejection necessitated by applicant's amendment. Nevertheless, it is expedient to consider the gist of applicant's comments.

**Applicant Argues:**

Applicant states in the paragraph joining pages 8 and 9 "Culliss fails to disclose a pay for placement market system having the features of independent claim 66 and independent apparatus claim 79. Lang does not provide the missing teaching."

**Examiner Responds:**

Examiner is nt persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., pay for placement market system) are not recited in the amended claims 66 and 79. Although the claims are interpreted in light of the specification, limitations from the specification

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are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### *Contact Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday between 8:00 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

8/11/2005

